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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,842	11/21/2001	Paul A. Moskowitz	CHA920010021US1	2704

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EXAMINER

NELSON, FRED A ANN

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/990,842

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Freda Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-14, 16-17, 23-25 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>02/28/04</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to a letter for a patent filed on May 17, 2001 in which claims 1-39 were presented for examination. Claims 1-39 are pending.

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 11/21/01, 12/18/01 and 02/19/03 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner. Copies of PTO-1449s are attached hereto.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 26-32, drawn to a method of securely communicating data between remote apparatus and a central server, classified in class 705, subclass 50.
- II. Claims 1-25, 33-38, drawn to a system for processing usage data within a local data processing system installed on a remote apparatus, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

806.05(e)). In this case, the apparatus as claimed can be used for calculating a charge based on usage.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Michael Hoffman on 2/28/05 a provisional election was made without traverse to prosecute the invention of Group II, claims 1-25, 33-38. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

A telephone call was made to the office of Attorney Michael Hoffman on 2/28/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-2, 10, 12, 14, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Dar et al. (US PG Pub. 2001/0039509).

In claims 1-2, 12, Dar et al. disclose that the vehicle-related services system includes at least one sensor on-board a vehicle (paragraph 0037); at least one communicator on-board the vehicle (paragraph 0038); and at least one data processor which provides a billing data output in respect of a vehicle-related service (paragraph 0039). Dar et al further disclose that without requiring any intervention by the driver, a parking communicator 104, receiving a location input from GPS receiver 102, transmits a message in a wireless manner to a central unit 106, which in turn provides data used for effecting payment for parking (paragraph 0125).

In claim 10, Dar et al. disclose that the data processor includes a vehicle insurance billing data processor(paragraph 0025).

In claim 14, Dar et al. disclose that a vehicle 100 is equipped with a GPS receiver 102 (paragraph 0125, FIG. 1A).

In claim 33, Dar et al. disclose that the vehicle-related services system includes at least one sensor on-board a vehicle (paragraph 0037); at least one

communicator on-board the vehicle (paragraph 0038); and at least one data processor which provides a billing data output in respect of a vehicle-related service (paragraph 0039). Dar et al further disclose that without requiring any intervention by the driver, a parking communicator 104, receiving a location input from GPS receiver 102, transmits a message in a wireless manner to a central unit 106, which in turn provides data used for effecting payment for parking (paragraph 0125). Dar et al. still further disclose that the central unit 1610 preferably employs the information contained in the composite messages received by it from various travel monitors 1604 to compute fees chargeable to individual vehicles, which are based, inter alia, on time duration of vehicle presence within given regions (paragraph 0241).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 16-17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Ando et al. (Patent Number 5,955,970).

In claims 3-5 and 16-17, Dar et al. does not disclose a security system comprising a tamper resistant encasement that encases at least one component of the local data processing system. Ando et al. disclose that the on-board device must

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include a security system for protecting monetary data stored therein and ensuring legitimate communication with the stationary device (col. 1, lines 26-30). Ando et al. further disclose that the illegitimate opening of the on-line device can be detected by sensing the removal of screws fastening a circuit board to a case of the on-board device (col. 2, lines 7-9). Ando et al. still further disclose that the switch is connected to a processor of the on-board device to detect the removal of the screws (col. 2, lines 11-13). Ando et al. further disclose that Detectors 5 and 7 detect a vehicle and set a timing of Communication between the on-board device and the stationary device. Gate entrance detector 9 and gate exit detector 10 set a timing of opening and closing the gate (col. 3, lines 30-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the security system feature of Ando et al. in order to protect the monetary data stored therein the sensor (Ando et al.; col. 1, lines 26-30).

In claim 23, Dar et al. disclose that the vehicle-related services system includes at least one sensor on-board a vehicle (paragraph 0037); at least one communicator on-board the vehicle (paragraph 0038); and at least one data processor which provides a billing data output in respect of a vehicle-related service (paragraph 0039). Dar et al. further disclose that without requiring any intervention by the driver, a parking communicator 104, receiving a location input from GPS receiver 102, transmits a message in a wireless manner to a central unit 106, which in turn provides data used for effecting payment for parking (paragraph 0125). Dar et al. does not disclose a security system which includes an encryption system. Ando et al. disclose

that the on-board device must include a security system for protecting monetary data stored therein and ensuring legitimate communication with the stationary device (col. 1, lines 26-30). Ando et al. further disclose that the illegitimate opening of the on-line device can be detected by sensing the removal of screws fastening a circuit board to a case of the on-board device (col. 2, lines 7-9). Ando et al. further disclose that the switch is connected to a processor of the on-board device to detect the removal of the screws (col. 2, lines 11-13). Ando et al. still further disclose that Detectors 5 and 7 detect a vehicle and set a timing of Communication between the on-board device and the stationary device. Gate entrance detector 9 and gate exit detector 10 set a timing of opening and closing the gate (col. 3, lines 30-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the security system feature of Ando et al. in order to protect the monetary data stored therein the sensor (Ando et al.; col. 1, lines 26-30).

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Ando et al. , in further view of Force et al. (Patent Number 5,533,123).

In claim 6, Dar et al. does not disclose that that the tamper resistant encasement comprises an epoxy having a signature embedded therein. Benson et al. disclose that various encryption schemes have been proposed, such as where a user creates and authenticates a secure digital signature, which is very difficult to forge and thus equally difficult to repudiate (col. 4, lines 16-19). Force et al. does not teach that the encasement comprises and epoxy, however it is old and well-known in the computer

arts that epoxy is more durable and tougher encasement. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the epoxy encasement to get the advantage of an inexpensive, but durable encasement.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Ando et al. , in further view of Force et al., still in further view of Davis et al. (Patent Number 5,844,986).

In claim 9, Dar et al. does not disclose that the processor comprises a Cryptographic coprocessor. Davis et al. disclose that a cryptographic coprocessor containing the BIOS memory device performs authentication and validation on the BIOS upgrade based on a public/private key protocol wherein the authentication is performed by verifying the digital signature embedded in the BIOS upgrade (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the feature of Davis et al. in order to prevent an attacker from trying to corrupt the BIOS contents (col. 2, lines 1-7).

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Ehrman et al. (US PG Pub. 2001/0037298),

In claim 11, Dar et al. disclose that there is also a vehicle-related fee payment system including at least one data processor which provides a billing data output in respect of a vehicle-related use fee which is dependent on the time during which the

vehicle is being operated (paragraph 0068). Dar et al. does not disclose that the charges comprises a rental cost. Ehrman et al. disclose that in some instances the results are entered into a hand held computerized recordation device for entry into the agency computer database for calculation of the final rental charge (either while the lessee waits or as a supplement to the original charge on the initially tendered credit card). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the feature of Erhman et al. in order to effect payments for vehicle-related services including vehicle rentals (paragraph 0002).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of McMillan et al (Patent number 6,064,970).

In claim 13, Dar et al. does not disclose that the sensor measures speed. McMillan et al. disclose that examples of data which will be monitored and recorded include: speeds driven (col. 6, lines 30-36). It would have been obvious at the time the invention was made to modify the invention of Dar et al. to include the speed measuring feature of Dar et al. to determine a fair cost of insurance (McMillan et al., col. 6, lines 46-49).

7. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Ando et al. in further view of Ehrman et al. (US PG Pub. 2001/0037298).

In claims 24-25, Dar et al. does not disclose that the usage payment comprises an insurance or a rental fee. Erhman et al. disclose that the customer enters a selected vehicle, punches in the prompted rental (e.g., rental duration, fuel option, insurance coverage option, return option, etc.) and identification information and, when instructed, swipes a credit card through the reader to activate the system, with transmission of all the information to the central billing and maintenance data base which transmits details to the checkout gate, where a rental agreement is printed out, when the vehicle arrives at the gate (paragraph 0031). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the payment feature of Erhman et al. in order to include in-vehicle check out and payment device operatively linkable to the transmitting sensor of the vehicle (Erhman, abstract).

8. Claims 34-35 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Shimizu et al. (US PG Pub. 2002/0111822).

In claims 34-35, Dar et al. disclose that the data processor includes a vehicle insurance billing data processor. Dar et al. does not disclose obtaining an electric payment. Shimizu et al. disclose that an IC card might be used to subtract the beneficiary fee or add the provider compensation shown in FIG. 60 through FIG. 65; and if employed to subtract beneficiary fees, it would function in the same way as a prepaid card and to add provider compensation, it would be used like a debit card (paragraph 0283). Shimizu et al. further disclose that if memory medium 5720 could

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also be used for general purchases (i.e., to pay for other transactions), its utility would be enhanced. If the memory medium does not have the capability of being used to pay for general purchases, it should still be able to be credited or debited in an ATM machine by accessing the information mediator's account and adding or subtracting the amount recorded on the card (paragraph 0283).

In claims 37-38, Shimizu et al. disclose that identity verification, then, is executed as preprocessing (setup) before data can be exchanged with the mediator. In other words, the mediator issues validation (data) 2701 to the machine or device to which it is connected via a network before the contract is in effect and based on these validation data, it can recognize which machine or device is communicating with it in the future wherein validation data 2701 may consist of a recognition code, a string in machine code used to recognize a machine or device, or they may be a cryptographic key or some other encrypted code (paragraph 0207).

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dar et al. in view of Shimizu et al. in further of Ehrman et al. (US PG Pub. 2001/0037298).

In claim 36, Dar et al. disclose that there is also a vehicle-related fee payment system including at least one data processor which provides a billing data output in respect of a vehicle-related use fee which is dependent on the time during which the vehicle is being operated (paragraph 0068). Dar et al. does not disclose that the charge is a rental cost. Ehrman et al. disclose that in some instances the results are

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entered into a hand held computerized recordation device for entry into the agency computer database for calculation of the final rental charge (either while the lessee waits or as a supplement to the original charge on the initially tendered credit card). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dar et al. to include the feature of Erhman et al. in order to include the feature of Erhman et al. in order to effect payments for vehicle-related services including vehicle rentals (paragraph 0002).

Conclusion

10. The examiner has cited prior art of interest, for example:

1) Amita (US PG Pub. 6,690,293), which discloses a gate apparatus, on-board unit, setup method of the on-board unit, toll collection method and judging method of the entrance and exit.

2) Berney (US PG Pub. 2003/0046228), which discloses an user-wearable functional jewelry with biometrics and smartcard to remotely sign and/or authenticate to e-services.

3) Chainer et al. (Patent Number 6,501,390), which disclose a method and apparatus for securely determining aspects of the history of a good.

4) Diaz (US PG Pub. 2002/0184062), which discloses a vehicle management system.

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5) Ehrman et al. (US PG Pub. 2001/0037298), which discloses a fully automated vehicle rental system.

6) Hershberg (Patent Number 5,289,369), which discloses a car rent system.

7) Morita et al. (US PG. Pub. 2002/0152115), which disclose a vehicle managing method.

8) "Crime Paves", August 1997, Automotive Industries, v 177, n 8, p 49-50.

9) Edwards, John ; "Rolling entertainment", May 2000, Upside, vol12n5, PP: 275-284.

10) Tyler, Geoff; "Vehicle recovery—the electronic way", Dec 1996, Management Services, v40n12, PP: 30-32.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda Nelson whose telephone number is (703) 305-0261. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Freda Nelson
Examiner
Art Unit 3629

 3/7/05
DEANT. NGUYEN
PRIMARY EXAMINER